

REMARKS

Reconsideration of the present application is respectfully requested.

Claims 2, 4, 5, 10, 11 and 18 stand objected to as being dependent upon a rejected base claim. In response, Applicants appreciate the indication of allowable subject matter and have amended claims 2, 4, 5, and 18 into independent form. A check in the amount of \$800.00 is included to cover the excess independent claim fees. This payment may be excessive due to confusion over the two independent method claims that currently stand withdrawn. Nevertheless, the Commissioner is authorized to charge any underpayment or credit any overpayment to deposit account number 500226.

With regard to the election requirement, there does not appear to be any evidence of record that the requirement was reconsidered and/or made final. Applicants respectfully assert that the present application includes only one invention and all of the claims should be examined. On previous occasions, the Patent and Trademark Office has examined single invention patent applications that included separate claims to apparatuses (e.g., fuel injectors) and methods. Among these are US Patents Nos. 7,059,301, 7,021,565, 6,997,159, 6,976,474, 6,955,114, 6,918,549, 6,880,769, 6,978,760, 6,951,204, 6,959,732, 6,959,699, 6,945,475, 6,933,660, 6,935,580, 6,854,442, 6,776,190, 6,725,838, 6,769,405, 6,749,129, 6,851,160, 6,769,635. This represents but a tiny fraction of similar applications where the Patent and Trademark Office has recognized a single application despite the fact that claims to methods and apparatuses are included in the same application. Applicants respectfully assert that it would be unfair to treat this application any differently. In addition, Applicants previously amended the claims to render moot the justification set forth in the earlier restriction requirement. Therefore, Applicants respectfully request that the restriction requirement be withdrawn or that the Examiner set forth a new justification supporting the restriction requirement and also explain how the restriction requirement can still be supported when MPEP §803 makes it clear that "if the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to independent or distinct invention", which this case does not. (Emphasis added).

Claims 1, 3 and 9 stand rejected under 35 USC §102(b) over Augustin. In response, Applicants have amended claim 1 in a way that better prevents it from being coincidentally

misread onto anything fairly taught by Augustin. In particular, Applicants have made it clear that when the control valve is in its first position, the high pressure fuel supply line is not fluidly connected to the check control cavity. There should be no dispute that such a configuration would be impossible with Augustin given its plumbing configuration. Therefore, Applicants respectfully request that the §102(b) rejections be withdrawn.

Claims 7 and 8 stand rejected under 35 USC §103(a) over Augustin. There is apparently no dispute that Augustin fails to show or suggest the claimed subject matter. Therefore, Augustin alone can not support a proper §103(a) rejection under the mandates of the MPEP and relevant case law. In addition, the assertion contained in the office action is flawed since there ought to be no dispute that the Augustin control valve 8 must be held closed against substantial pressure from a high pressure common fuel rail. Augustin shows this as being done by applying high pressure to the opposite end of its control valve. If one were to substitute the structure required by Applicants claims as per the office action, an extremely powerful spring would be needed to hold the valve closed against common rail pressure, and an even larger and more powerful solenoid or other electrical actuator would be required in order to open the valve against the spring strength. In fact, such a powerful solenoid and spring would likely not even fit onto the page illustrating the Augustin fuel injector. Therefore, the logic of the office action is flawed, and because Augustin neither shows nor suggests what Applicants have claimed, it can not alone support a §103(a) rejection. Therefore, Applicants respectfully request that the outstanding rejections under §103(a) be withdrawn.

Applicants respectfully request an initialed copy of the IDS form that accompanied the application when originally filed. A copy of that form is attached hereto. If that form was lost by the Patent and Trademark Office, Applicants respectfully request an indication of that status so that the required submission can be made so that the cited references are considered.

An additional information disclosure statement is attached hereto. Applicants respectfully request that the newly cited reference be considered and that an initialed copy of that IDS form also be returned in any subsequent action.

This application is now believed to be in condition for allowance of claims 1-5, 7-12, 14, 15, and 18-21. However, if the Examiner believes that some minor additional clarification would put this application in even better condition for allowance, the Examiner is invited to

contact the undersigned attorney (812) 333-5355 in order to hasten the prosecution of this application.

Respectfully Submitted,

A handwritten signature in black ink, appearing to read 'MBM', written in a cursive style.

Michael B. McNeil
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